



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,988	04/08/2004	Francisco Faoro	ZIM0353	9041

7590 09/20/2007  
John F. Hoffman, Esq.  
BAKER & DANIELS LLP  
Suite 800  
111 East Wayne Street  
Fort Wayne, IN 46802

EXAMINER
----------

SCHILLINGER, ANN M

ART UNIT	PAPER NUMBER
----------	--------------

3738

MAIL DATE	DELIVERY MODE
-----------	---------------

09/20/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/820,988	Applicant(s) FAORO, FRANCISCO	
	Examiner Ann Schillinger	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☒ Claim(s) 15-19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Allowable Subject Matter***

Claims 15-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by DeOrio et al. (U.S. Pat. No. 5,681,316). DeOrio et al. discloses the following of claim 1: an apparatus for the fixing of the position of bone cuts for the insertion of knee implants, comprising at least one cutting jig (10) which is adapted to be coupled to a base element (28, 32) fixed to the bone in the region of a condyle and is adapted to be fixed to the base element (see Figure 4), wherein the cutting jig includes a first slot (12) for a cutting tool defining a first cutting plane (vertical plane through element 12) with respect to the base element and a second slot (opening on element 26) for a cutting tool defining a second cutting plane (horizontal plane through slot on element 26), wherein at the cutting jig the orientation of the second cutting plane is rotatably adjustable relative to the first cutting plane while the cutting jig is remains coupled to the base element and while taking the respective knee anatomy into account (see Figures 3, 4; col. 3, line 44 through col. 4, line 3).

Art Unit: 3738

DeOrio et al. discloses the limitations of claims 2, 3, 6, 7, 11, and 14 according to the disclosure given for claim 1 above and as seen in Figure 4.

DeOrio et al. discloses the limitations of claim 4 in col. 6, lines 6-26.

DeOrio et al. discloses the limitations of claims 5 and 8 where the abutment element is 60 and the guide is element 106.

DeOrio et al. discloses the limitations of claim 9 where the abutment pin is element 104.

DeOrio et al. discloses the limitations of claim 10 where the probe device is elements 16, 20, and 102. Please also see Figure 4.

It should be noted that the claim language "adapted to/for" is functional language. In order to be given patentable weight, a functional recitation must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being anticipated by DeOrio et al. in view of Duffner (U.S. Pat. No. 6,796,986). DeOrio et al. does not disclose the turntable feature of the cutting jig for ease of use. However, Duffner discloses an apparatus with a cutting jig (200) defining slots (270) with two cutting planes, where the two cutting slots are adjustable relative to each other via the radially moving arms (140, 120) and relative to the base (110, 130)

Art Unit: 3738

via sliding along the arms, where the cutting jig (20) may be moved parallel to the cutting plane by sliding along the arms (140, 120). The slot guides (16, 18) may also be used simultaneously for cutting and an additional abutment, also the edges of each slot form abutment elements for the cutting tool to restrict the cut, alternatively the holes of the apparatus (Figure 11) may form guides for abutment instruments (being pins) or the arms (120, 140) may be guides for an abutment instrument, where an abutment instrument using at least one of these guides is fully capable of intersecting all planes of cutting where all abutments are coupled to the slot element or are the slot element themselves. The cutting jig, further encompasses a clamping device (170, 175) with an actuating member (130) by which the clamping element (170, 175) is fixed to the base element (110, 130) and simultaneously, the orientation of a cutting plane can be fixed relative to another cutting plane. The knob (170) is a turntable arrangement that is rotatably supported on the cutting jig (110), where the axis of the knob is perpendicular to the cutting planes and the cutting guides (200) are rotatably connected to the turntable and are capable of forming a guide for an abutment. Rotating the turntable structure will correspond to a change in the guide structure, which is also rotatable (col. 3, lines 31-45). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize this turntable feature to make it easier to use the cutting jig.

### ***Response to Arguments***

In view of the amendments to the Specification submitted on 7/5/2007, the objections to the drawings are withdrawn.

Applicant's arguments with respect to claims 1-11 and 14 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 3738

Regarding claims 12 and 13, the Applicant's arguments filed 7/5/2007 have been fully considered but they are not persuasive. Applicant contends that element 170 in the Duffner reference cannot be considered a turntable. However, claims in a pending application should be given their broadest reasonable interpretation. In re Pearson, 181 USPQ 641 (CCPA 1974). A turntable is defined as "a rotating platform or disk..." (turntable. Dictionary.com. The American Heritage® Dictionary of the English Language, Fourth Edition. Houghton Mifflin Company, 2004. <http://dictionary.reference.com/browse/turntable> (accessed: September 12, 2007)). In view of this definition, the element cited in Duffner meets the limitations. The Applicant also contends that the Duffner reference does not have a rotating guide section. It is stated above and in the previous office action that Duffner describes the guide section as rotatable in col. 3, lines 31-45. Please note that the Duffner reference was used primarily for its turntable feature, and that the reference under the 35 USC § 102 rejection has the features of the invention.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 3738

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Schillinger whose telephone number is (571) 272-6652. The examiner can normally be reached on Mon. thru Fri. 9 a.m. to 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ann Schillinger  
September 12, 2007

*A. Stewart*  
ALVIN J. STEWART  
PRIMARY EXAMINER